

## **URGENT: POSSIBLE DIVISIONAL APPLICATION FILINGS BY NOVEMBER 1, 2007**

On September 26th, the United States Patent and Trademark Office (USPTO) updated its Frequently Asked Questions concerning new USPTO Rule 78(d)(1), (72 Fed. Reg. 46716, August 21, 2007). The practical effect of this explanation is that by November 1, 2007, all divisionals must be filed for any invention that was restricted in the United States, but that was examined under Chapter II in an earlier filed PCT application that designates the United States.

This includes PCT applications in series or in parallel with the U.S. application. That is, both PCT applications that are in the benefit chain of the U.S. application and PCT applications (that designate the United States) that are filed separately and parallel to the U.S. application are included.

You must file all such divisional applications before November 1, because, as explained by the USPTO, on and after November 1, applications that contain claims that were examined in an earlier filed PCT application under Chapter II will not be able to satisfy the requirements for a divisional application. This explanation was posted by USPTO with little over a month's notice before the rules take effect.

The specific Frequently Asked Questions of interest are C11 and C8. In C11, the USPTO explains:

"[I]f applicant filed a Demand and paid the additional examination fees and all of the inventions were examined in the international application, applicant may not file a divisional application. This is because under PCT Article 31, 'examination' in the international phase is contingent upon the filing of a Demand for international preliminary examination. The non-elected invention would be examined within the meaning of 37 CFR 1.78(d)(1)(ii) in the international application designating the U.S." [emphasis added]

For example, an applicant had a PCT Chapter II examination at the EPO of all or some of claims. The applicant then entered the U.S.

The U.S. examiner split the claim set into 7 groups. Group I was elected. Groups II-VII were withdrawn. Groups II-VII contain claims to inventions that were examined under PCT Chapter II

ALL divisionals to withdrawn claims II-VII in which the Applicant may have an interest must be filed by November 1, and in separate applications, so that they are grandfathered under the old rules for divisionals.

### **TO DO:**

1. All dockets in which a client has filed a PCT application in the family need to be reviewed.
2. Families that utilized PCT Chapter II need to be identified.
3. The claims that were examined in PCT Chapter II need to be identified.
4. It needs to be determined if the claims that were examined in PCT Chapter II are withdrawn or pending at the USPTO.
5. If the claims are withdrawn at the USPTO, a divisional application need to be filed before November 1<sup>st</sup>.
6. For recent applications, if it is possible that the claims may be restricted in a future restriction requirement, consider whether to file a voluntary divisional before November 1 with groups divided along the lines of the PCT's lack of unity.